

REMARKS

Claims 1-24 are pending in this application.

Objection to Claims 16, 23 and 24

The Examiner has withdrawn the objections to claims 16, 23 and 24.

Summary of Interview

On October 17, 2006, Examiners Stevens and Alam conducted an in person interview. The Examiners' courtesy is most appreciated. Progress seemed to have been made. We agreed that it was unnecessary to recite any agreements in the interview summary, but amendments were discussed that potentially overcome all rejections under § 112.

During the interview, one issue addressed was the § 101 issue of whether an interface that converts user requests into search criteria is "useful." We pointed out that the Examiner offered Jeremy Nixon's Deja Power Search interface as a reference. Mr. Nixon prepared at least two versions of the interface, convinced that it was useful. He published and revised his utility, which prepares search criteria but does not conduct searches. After reviewing Mr. Nixon's work, no disagreement was expressed over the usefulness of the claimed subject matter.

We addressed § 112 rejections and specifically discussed amendments substantially similar to the amendments submitted above. We moved onto the next subject, once there was no disagreement regarding the nature of amendments that would overcome the § 112 issues.

Regarding Mr. Nixon's work and § 103 rejections, we put the HTML source code for his interface on the table and went over it. The Examiners both indicated their familiarity with reading HTML source code. The point of looking at the source code behind the pages that were cited as a reference was to determine just how the selection filters worked. It was apparent from the HTML source code that the filters were programmed to act independently. None of the filters was sensitive to the context created by a prior filter value or selection. For instance, selecting a particular "archive" using that filter did not change the selections available through any other filter. This conclusion was easily reached upon examining the HTML.

Rejection of Claims 1-22 under 35 U.S.C. §101

The Examiner continues his rejection of claims 1-22 under 35 U.S.C. §101, arguing that the claimed invention is directed to non-statutory subject matter.

An interface that organizes a user's selections into search criteria that can be passed to a search engine is a useful tool. Mr. Nixon published his less-refined tool, updated it and republished it. That is objective evidence of usefulness.

Therefore, the rejections under § 101 should be withdrawn.

Rejection of Claims 5-7, 12-14 and 20-22 under 35 U.S.C. §112, first paragraph

The Examiner continues his rejection of claims 5-7, 12-14 and 20-22 under 35 U.S.C. §112, first paragraph as failing to comply with the enablement requirement.

The proposed amendments, which we discussed during the interview, should overcome these § 112 rejections. Amendment of claims 5-7, 12-14 and 20-22 deletes the words "a character string." It is well recognized that deleting a claim limitation effectively broadens the claim.

Rejection of Claims 1-24 under 35 U.S.C. §112, second paragraph

The Examiner continues his rejection of claims 1-24 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The proposed amendments, which we discussed during the interview, should overcome all of these § 112 rejections.

Amendment of claims 1, 8, 15, 23 and 24 should not narrow the scope of the claims, as the amendments primarily involve changing "one or more" to "at least one", which does not change the claim scope. This is a useful wording change, because the subject changes from plural to singular, which reads better in subsequent references within the claim. Changing "fields" to "field" etc. does not narrow the claim. If anything, it broadens the claim. Changing "respective" to "a selected" more likely broadens than narrows the claim, because it requires only one context sensitive value specification. The final change, "sending search criteria to a search engine that searches" makes it clear that the claim reads on a method that stops short of performing an actual search. This effectively broadens the claim, which previously referred to searching.

Amendment of claims 16, 23 and 24 involved less editing. The phrase "determined using the document type selection filter" makes explicit what one of skill in the art would have found implicit in the claim before amendment.

We point out that none of the amendments respond to prior art references.

Rejection of Claims 1-4, 8-11, 15-19, 23 and 24 under 35 U.S.C. §103(a)

The Examiner continues his rejection of claims 1-4, 8-11, 15-19, 23 and 24 under 35 U.S.C. §103(a) as being unpatentable over the Deja Power Search Graphical User Interface Form ("Deja Power Search Graphical User Interface," downloaded from www.exit109.com/~jeremy/news/deja.html, © Feb. 12, 2000, pp. 1-20) in view of Mehmet Altinel et al. ("Efficient Filtering of XML Documents for Selective Dissemination of Information," Proceedings of the VLDB Conference, Cairo Egypt, Sep. 10-14, 2000, pp. 53-64).

As discussed during the interview, the HTML source code for Mr. Nixon's interface makes it clear that none of the filters are context sensitive to choices made using other filters. Therefore, the Deja interface does not supply the elements for which the Examiner relies on it. The obviousness rejection should be withdrawn, without any need to reach the Altinel-related issues.

Regarding the second reference the Examiner cites, the Examiner parses what we wrote as seven arguments. See, FOA at 6-7. We will try to adopt the Examiner's structuring, pointing out arguments that were overlooked by the Examiner as "unnumbered".

[First (by the Examiner's numbering),] Altinel does not include the context sensitive selection filters that are missing from Mr. Nixon's Deja interface. The Examiner responds, FOA at 7, "If search results are dependent upon field entries, those fields are, of necessity, context sensitive." In the amended claims, searching is not an element of the claims. The claims focus on organizing a user's selections into search

criteria. The Examiner's argument is faulty because it assumes that searching must be part of the claim.

[Third,] Altinel teaches nothing about the operation of GUIs, only the efficient organization of a filter for XML documents being added to a database. The Examiner replies (FOA at 7) that "the references teach as a whole the well known concept of search engines or GUIs." This reply mixes up teaching, looking at a single reference "as a whole" and what is "well known." The Examiner's argument is not a rejoinder to our point that Altinel teaches efficient organization of a filter for XML documents being added to a database, which does not read on any of the elements of our graphical interface. Altinel is not about graphical interfaces.

[Second and unnumbered,] Altinel does not meet either the *non-displaying fields* sub-element of *providing a graphical user interface* or the *receiving the selected* element. The Examiner relies on Altinel p. 53 last paragraph and p. 55 ¶¶ 1-2 (OA at 9) to meet these elements, having acknowledged that these elements are lacking from the Deja GUI. *Id.* Before addressing those specific paragraphs, we point out that the only reference to a graphical user interface (GUI) in Altinel appears on page 54 § 2.1, in the context of describing how users fill in profiles from which filters are created ("standing queries ... applied to all incoming documents"). There is no suggestion that the GUI in Altinel § 2.1 meets the claimed elements, because it does not.

Turning to p. 53, last paragraph, this paragraph describes part of a filtering engine applied to documents being added to a database. It does not address any element of the claim, because it does not discuss a GUI or a search engine. Regarding p. 55, ¶¶ 1-2 and more generally § 2.2, these paragraphs only show an XPath expression for describing a filter. This part of Altinel does not go much beyond the disclosure of this application. Applicants have not claimed XPath expressions as their invention. The dependent claims that combine XPath with claim 1 refer to *path specifications are compliant with any version of an XPath standard*. Citation of Altinel is unavailing because it does not supply any element of the claim.

Regarding the unnumbered argument, the FOA does not address the *receiving the selected* element.

In the FOA at 7, the Examiner abandons reliance on Altinel to meet the *non-displaying fields* sub-element and instead argues that "the concept of non-displaying or

hidden GUI fields was well known in the art ...” Of course, many patentable inventions are made by using well known elements in ways in which they have not been used before. The Examiner’s challenge is to find a reference that uses non-displaying fields in the manner claimed. In the FOA, the Examiner does not make this showing, relying instead on an assertion that it is well known, which leads to our demand for an affidavit.

[Fifth,] the Examiner’s references to use of XPath and non-displaying fields in ways relevant to this claim as being “well known” are hereby challenged and an affidavit is again demanded. *E.g.*, OA at 9, 10, 12, 15, 18, 21 & 24 (XPath) & 9, 10, 12, 15, 18, 21, 24 & 27 (XML); FOA at 7. We do not dispute that XML and XPath are standardized languages and that non-displaying fields are supported by the HTML specification — we say as much in the dependent claims. But combination of these technologies with the features claimed is not disclosed in Altinel and is not described in Altinel as being well-known. Let us be clear: under MPEP § 2144.03, Applicants respectfully request an examiner’s declaration or affidavit in support of the argument that use of XPath and non-displaying fields in ways relevant to this claim as being “well known”. The Examiner cannot fall back to an assertion that something is “well known” simply to make up for the lack of a reference on point. In the face of a challenge, the Administrative Procedures Act and the MPEP require that the Examiner swear out a declaration so that it may be considered, challenged and weighed on appeal as evidence.

Thus far, the Examiner has responded, “Applicants desire for an affidavit regarding the teachings of Altinel is confusing, as the Altinel reference pre-dates Applicant’s subject matter, and thus was well known in the art at the time of Applicant’s subject matter.” The discussion above eliminates any room for confusion. If the Examiner is not characterizing anything as well known and instead intends to rely on the four corners of Altinel, no affidavit is needed. However, if the Examiner wants to go beyond the four corners of Altinel, an affidavit must be submitted in compliance with the APA and MPEP.

[Sixth,] the proposed motivation to combine references is troubling because neither of references supply the elements of claim 1, so it is difficult to imagine how Altinel would motivate Jeremy Nixon (or anyone else) to rewrite the Deja GUI. Our appeal brief, pp. 3-4 & 9-10, **[seventh]** which we hereby incorporate by reference, sets forth the standard for the Examiner to meet. The standard is not met because the

Examiner is using hindsight and the claim as a roadmap for combining the references. Jeremy Nixon and those of ordinary skill in the art would not be inspired to consult Altinel for creative ideas on how to write a GUI for a search engine – Altinel presents a filtering system, not a search engine!! It would take an inventive step to combine Deja GUI and Altinel, because they are so divergent. The Examiner's reasoning is that combining the references "would have enabled a programmer to develop a document filtering system that provided highly efficient matching of XML documents to large numbers of user profiles, as taught by Altinel in the last paragraph of page 53 ('We have developed....')." This motivation does not lead to a combination that would read on the elements of claim 1. The only source for combining these references to read on claim 1 is using hindsight with claim 1 as a roadmap, which is not a permitted basis for asserting § 103(a).

Regarding the Appeal Brief, we reference it to save on pages in this response. The legal standards previously presented should be kept in mind for this case.

Regarding the motivation to combine references, the Examiner responds (FOA at 7) that the references are in the same field of endeavor, which begs the question. Motivation to combine and field of endeavor are separate issues. The Examiner must prove motivation to combine, even when if the references are in the same field of endeavor. The Examiner does not endeavor in the FOA to prove a *prima facie* motivation to combine.

One of the reasons that a motivation to combine cannot be shown is because Altinel has nothing to teach Jeremy Nixon. The statutory "as a whole" rule of Section 103 prohibits this use of hindsight to combine elements in a manner not taught or suggested by the references. The Federal Circuit explained in *Ruiz v. A.B. Chance*, 357 F.3d 1270, 1275, 69 U.S.P.Q.2d (BNA) 1686 (Fed. Cir. 2004):

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning,

using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350, 1355- 56 (Fed. Cir. 1998).

See, *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337, 75 U.S.P.Q.2d (BNA) 1051 (Fed. Cir. 2005) (reciting *Ruiz* rule; "simply identifying all of the elements in a claim in the prior art does not render a claim obvious"); 2-5 Chisum on Patents § 5.03 [2][c] n. 29 (2005 Lexis version); e.g. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.' "). The Federal Circuit has rejected the Examiner's approach of using a general statement that the references are in the same field as endeavor to combine elements in a manner claimed, which is not taught or suggested by the references. This general approach has been rejected both as lacking the required evidentiary support (*In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d at 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1369-70 (Fed. Cir. 2000); *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541 (Fed. Cir. 1997)) and because the logic applied is prohibited by statute (*Ruiz*; *Princeton Biochemicals*).

Altinel simply does not have any suggestions to which Jeremy Nixon would turn about how to write a graphic interface. There is no motivation to turn to Altinel as a secondary reference or to take anything from Altinel to combine with Nixon's interface,

because the graphic interface in Altinel does not supply the elements for which the Examiner relies on it.

[Fourth,] claims 2 & 4 include limitations that require compliance of path specifications received from a GUI interface with an XPath standard. The Examiner's efforts to combine Deja GUI with Altinel fail for the reasons stated above. There is no basis for engrafting XPath onto Deja GUI – Jeremy Nixon's simple GUI has none of the intelligence or sophistication that would be involved, as apparent from even a quick look at the attached HTML source code.

The Examiner responds, "art reading on the narrower dependent claim also reads on the broader independent claim," which begs the question. Altinel does not use XPath in any way that is relevant to these claims or to Nixon's interface. Finding a reference that uses XPath to perform a different function, in a different way, with a different result does not meet the Examiner's *prima facie* burden of providing evidence of a teaching, motivation or suggestion to combine the elements from the references in the manner claimed.

[Unnumbered,] claim 3 limits the documents being searched to XML-compliant documents. As neither of the references describes a search engine applied to XML-compliant documents, the Examiner has not made out a *prima facie* case of obviousness. The FOA does not respond to this position regarding claim 3.

[Unnumbered,] claim 8 puts the burden of translating document types and similar information into XPath specifications on a receiving device, instead of the GUI. The cited references do not include the claimed elements, so this alternative allocation of tasks between the GUI and the device is not met by the combination, for the reasons stated above. The FOA does not respond to this position regarding claim 8.

For these reasons, claims 1-4, 8-11, 15-19, 23 and 24 should be allowable over Deja GUI in view of Altinel.

Rejection of Claims 5-7, 12-14 and 20-22 under 35 U.S.C. §103(a)

The Examiner continues his rejection of claims 5-7, 12-14 and 20-22 under 35 U.S.C. §103(a) as being unpatentable over DPSGUI in view of Altinel, and further in view of Adar et al. (US 6,493,702).

These claims should be allowable for at least the same reasons as the claims from which they depend.

CONCLUSION

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims as now stated.

Applicants would welcome an interview, if the Examiner is so inclined. The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Fee Authorization. The Commissioner is hereby authorized to charge any fee determined to be due in connection with this communication to our Deposit Account No. 50-0869 (OIN 1009-1).

Respectfully submitted,

Dated: November 20, 2006

_____/Ernest J. Beffel, Jr./

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